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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/068,507	07/15/1998	VINCENT G. H. EIJSINK	1380-122PCT	2387
2292	7590	10/09/2003		
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
			EXAMINER	
			SLOBODYANSKY, ELIZABETH	
			ART UNIT	PAPER NUMBER
			1652	

DATE MAILED: 10/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/068,507	Applicant(s) EIJ SINK ET AL.	
	Examiner Elizabeth Slobodyansky	Art Unit 1652	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 September 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 30 May 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 69-85, 87-107, 109-125.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

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Attachment to the Advisory action

The substitute Sequence Listing and the computer readable form thereof filed September 10, 2003 have been entered.

The AF amendment filed September 10, 2003 canceling claims 1-106 and 112-125, amending claims 107 and 109-111 and adding claims 126-134 has not been entered for the following reasons.

The claims as amended would require further consideration and/or search and possibly new rejections. The scope of claim 107 has been changed. It is unclear whether the claim is drawn to a naturally occurring promoter that is located "upstream from a -10 region of a bacterial gene" only or to a variant promoter as well. Applicants describe naturally occurring promoters (SEQ ID NOs: 6-10). However, the entire genus of promoters of claim 107 comprising the recited DNA fragments is neither described nor enabled. The function of the promoter is not described as it is not defined by which compound it is inducible. The genus of promoters is not enabled as there is no guidance as to which modifications can be made so that the sequence comprising the recited DNA fragments would remain inducible either by its own or by any undefined inducer. The naturally occurring promoters are inducible by their own inducers. For example, promoters of SEQ ID NOs: 6-7 are inducible by residues 19-37 of SEQ ID NO: 3. There is no evidence that SEQ ID NO:1, for example, induces SEQ ID NOs: 6-7.

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With regard to the written description, Applicants argue that "All of these features are explicitly shown in the Figures" (Remarks, page 12). Note that only naturally occurring sequences are explicitly shown. With regards to the arguments related to the repeats, these repeats are not inducible by an inducer other than the cognate inducer. The relationship between the structure and the function of the inducible promoter is not disclosed. With regard to the enablement, Applicants argue that peptide consisting of residues 19-37 of SEQ ID NO:3 acts as an inducer in *L. sake* and that PlnA gene product is an inducer in *L. plantarum* C11 (pages 19-20). However, these facts do not render said inducers interchangeable and moreover acting on other promoters within the genus of claim 107.

With regard to 112, 2nd paragraph, the outstanding rejection is not applicable to the amended claims.

The proposed amendment to the specification is redundant as it duplicates the amendment of February 1, 1999.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Slobodyansky whose telephone number is (703) 306-3222. The examiner can normally be reached Monday through Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Ponnathapura Achutamurthy, can be reached at (703) 308-3804. The FAX phone number for Technology Center 1600 is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Center receptionist whose telephone number is (703) 308-0196.

A handwritten signature in cursive script, reading "E. Slobodyansky". The signature is written in black ink and is positioned above the printed name and title.

Elizabeth Slobodyansky, PhD
Primary Examiner

October 8, 2003